



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2876
Examiner: Karl D. Frech

Application of: Paul O. DETWILER, et al.
Serial No. : 09/815,882
Filing Date : March 23, 2001
Entitled : OPTICAL SCANNER HAVING
ENHANCED ITEM SIDE COVERAGE

ATTENTION: Honorable Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Att: Director of Art Unit 2876

PROTEST UNDER 37 CFR 1.291

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Sir:

I. INTRODUCTION

Pursuant to 37 CFR §1.291 (2004), the undersigned attorney, representing PSC Scanning, Inc. ("PSC"), protests the issuance of a patent, from United States Reissue Application 09/815,882 ("the '882 Reissue"), and wishes to bring the issues listed below to the attention of the Examiner. A copy of this protest is being served, pursuant to 37 CFR §1.248 (2004), by first class mail on Paul W. Martin, attorney of record for NCR Corporation ("NCR") in the '882 Reissue. This document is the first protest submitted in the '882 Reissue application by PSC, the real party in interest, and is based on the following two grounds, either of which is sufficient to forestall reissuance of the patent:

A. The '882 Reissue contains claims that are broader than those for which NCR is legally entitled to apply, and were added more than two years after the grant of the original patent, U.S. Patent No. 5,684,289 ("the Detwiler '289 Patent"). In particular, claims 36-92 are broader in scope than claims 22-32, the only claims that remain in the original patent after claims 1 to 21 and 33 to 35 were statutorily disclaimed. Under controlling legal authority, discussed below, NCR can only predicate a right to reissue claims upon claims 22 to 32.

B. The issuance of the '882 Reissue is estopped by NCR's failure to address the patentability to NCR of the claims presented in the '882 Reissue during Interference No. 104,631 ("the '631 Interference") involving the Detwiler '289 Patent, which resulted in a judgment adverse to NCR. See, 37 CFR §41.127 (2004).

An analysis of each of these two issues follows a brief statement of the background facts.

II. CONCISE STATEMENT OF RELEVANT BACKGROUND

The '631 Interference was declared on Nov. 1, 2000 between the Detwiler '289 Patent, assigned to NCR, and U.S. Patent Application No. 09/078,196 ("the Bobba '196 Application") assigned to PSC. See, Notice Declaring Interference. The Detwiler '289 Patent was filed on Oct. 30, 1995, and issued on Nov. 11, 1997, with thirty-five (35) claims. The Bobba '196 Application was filed on May 13, 1998, and claims an earliest priority date of July 14, 1992.

Both the Detwiler '289 Patent and the Bobba '196 Application disclose a dual plane scanner which is an "L" shaped scanner having a horizontal window and a vertical window, and both address, in significant part, the same problem: the difficulty of scanning a fifth side of an item moved through the scan volume of an "L" shaped dual plane scanner.

A typical item being scanned has six sides that can be identified relative to the scanner orientation. The bottom side faces downward toward the horizontal window. The top side faces upward. The leading side faces the direction of motion of the item as it is passed through the scan volume, and the trailing side is the side opposite the leading side. The customer side faces the vertical window. Finally, the checker side faces away from the vertical window.

In an "L" shaped scanner, scanning the bottom side is easily accomplished because it faces the horizontal window. Scanning the customer side is easily accomplished because it faces the vertical window. The leading and trailing sides are both oriented at 90° from both the vertical and horizontal windows, but scan lines from both windows can still reach the item to be scanned, thereby allowing the formation of a sufficient density of scan lines at different orientations to scan those sides. However, scanning a fifth side (the top side or checker side) is much more difficult as neither of these sides face either the horizontal window or the vertical window, and because the fifth side is oriented at about 90° from the respective adjacent window, scan lines can

reach the fifth side from at most one window. This orientation makes it difficult to project a sufficient number of scan lines on to either of these fifth sides.

Claim 14 of the Bobba '196 Application and claim 18 of the Detwiler '289 Patent were held to constitute Count 1 of the '631 Interference. Claim 52 of the Bobba '196 Application and claim 1 of the Detwiler '289 Patent were held to constitute Count 2. Only claims 22-32 of the Detwiler '289 Patent were found not to correspond to either count.

On March 22, 2001, more than two years after the issuance of the Detwiler '289 Patent, NCR filed the '882 Reissue application, claiming that it had previously "claim[ed] more than they had the right to claim," because the structure disclosed by the two counts of the '631 Interference had been disclosed in an earlier patent, U.S. Patent No. 5,299,588. NCR also noted that claims "such as 36 to 55...add features not present in their earlier '588 patent" and "should have been included in the Detwiler '289 patent." See, Reissue Application Declaration By the Assignee, dated March 22, 2002.

On April 2, 2001, NCR filed a Disclaimer under 37 CFR §1.321(a), thereby disclaiming claims 1 and 18 of the Detwiler '289 Patent, the claims that corresponded to the counts in the '631 Interference.

On April 11, 2001, PSC filed a preliminary motion to Substitute Proposed Count 3 for Counts 1 and 2. As contemporaneously noted, a purpose of this substitution was to "redefine the count to ensure that the count defines patentable subject matter encompassing the various claims of the parties;" *i.e.*, the "ability to scan a fifth side." On

May 16, 2001, NCR filed a second disclaimer, disclaiming claims 2-17, 19-21, and 33-35 of the Detwiler '289 Patent. NCR then filed a Request For Entry of Adverse Judgment, which was granted on June 7, resulting in an adverse judgment against the Detwiler '289 Patent, and the dismissal of the '631 Interference.

There was never a ruling upon PSC's Motion to Substitute Proposed Count 3, directed toward the scanning of the fifth side, because NCR took an Adverse Judgment rather than address the issues raised by Proposed Count 3. Significantly, the ability of an "L" shaped scanner to scan the fifth side of an object is the subject of claims of the '882 Reissue. Consequently, NCR is now attempting to capture, through reissue, claims it could have raised in the earlier interference, and actually prevented from being considered by refusing to accede to PSC's preliminary motion to add them.

III. THE PRESENT APPLICATION IMPROPERLY BROADENS THE SCOPE OF THE ORIGINAL PATENT MORE THAN TWO YEARS AFTER THE GRANT OF THE ORIGINAL PATENT.

35 U.S.C. § 253 provides that "A patentee . . . may . . . make disclaimer of any complete claim. . . . Such disclaimer shall . . . thereafter be considered as part of the original patent." (emphasis added). The term "original patent," just discussed in connection with §253, is also used in §251 to define the scope of permissible reissue claims. See, 35 U.S.C. § 251 ("No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."). (emphasis added). A term in two closely related statutes is presumed to have

the same meaning in both. United Sav. Ass'n v. Timbers of Inwood Forest Assocs., 484 U.S. 365, 371 (1988) (stating that same term used in related statute clarifies meaning of term). The same is true here. See, Vectra Fitness, Inc. v. TNWK Corp., 162 F.3d 1379, 1383 (Fed. Cir. 1998) (addressing the interplay between the term "original patent" in §§251 and 253 in holding that a reissue application filed more than two years after grant of original patent is bound by claims remaining in patent after disclaimer is filed).

Employing this statutory construction, the Federal Circuit has interpreted the phrase "considered as part of the original patent" to invoke a temporal fiction that makes it as if the disclaimed claim never existed as part of the original patent. See, Vectra Fitness, 162 F.3d at 1384. The Vectra court noted that if the disclaimed claims were considered part of the original application for purposes of §251 "a patentee would be able to reclaim previously disclaimed subject matter at any time during the term of the patent." Vectra Fitness, 162 F.3d at 1384. The Federal Circuit further noted that:

[N]othing would prevent the patentee from filing at any time a reissue application that reclaimed most of the disclaimed subject matter because the patentee could never be said to be broadening the scope of the original claims. This partial recapture would effectively render disclaimers a nullity. The public could never rely on the scope of the non-disclaimed claims. To be safe from allegations of infringement, the public would have to avoid almost the entire scope of the claims as originally filed because, at any time, a patentee could file a reissue application that included a claim recapturing most of the subject matter previously disclaimed. In short, allowing Vectra to later recapture some of the subject matter that was explicitly disclaimed would negate the finality and certainty of the disclaimer.

Vectra Fitness, 162 F.3d at 1384.

When NCR disclaimed Claims 1-21 and 33-35, the law deemed the original patent to be rewritten as if those claims never existed. Accordingly, the analysis of

whether the '882 Reissue is improperly broadening hinges on whether claims 36-92 are broader than claims 22-32, the only claims in the "original patent" post-disclaimer. See also, MPEP § 1412.03.

A claim in a reissue application enlarges the scope of the original patent claims if it is broader in any respect, even though it may be narrower in other respects. In re Ruth, 47 C.C.P.A. 1014, 1016 (1960); see, MPEP § 1412.03.

Claims 36-92 are broader in scope than claims 22-32. Claims 22, 23, 24 and 28 are the only remaining independent claims in the original Detwiler '289 Patent. Claims 25-27 and 29-32 are dependent claims and are necessarily narrower than the independent claims. Claims 22, 23 and 28 require:

a first set of pattern mirrors including at least primary and secondary mirrors, and at least one tertiary mirror; wherein each of the primary mirrors of the first set being disposed to receive an incident light beam at an oblique angle to reflect the incident beam onto at least one of the secondary mirrors of the first set; wherein each of the secondary mirrors of the first set being disposed to receive an incident light beam at an oblique angle to reflect the incident beam onto at least one of the tertiary mirrors of the first set; wherein the tertiary mirror of the first set being disposed at an oblique angle with respect to an incident light beam from at least one of the secondary mirrors of the first set, and positioned to reflect the incident beam outwardly and downwardly through said substantially vertical aperture.

Additionally, claim 24 requires:

[A]t least first, second, and third sets of pattern mirrors located within the housing along the periphery of said area; said first set of pattern mirrors being located in one region along said periphery, and having primary and secondary mirrors, and at least one tertiary mirror for reflecting light beams outwardly and downwardly through said substantially vertical aperture...wherein the primary mirrors of the first set include a plurality of

generally trapezoidal mirrors; wherein the secondary mirrors of the first set operate to receive a light beam from said generally trapezoidal mirrors; and wherein the tertiary mirror of the first set is a generally trapezoidal mirror which operates to receive a light beam from said secondary mirrors of the first set.

These limitations are not found in claims 36-92, and accordingly, while the above example is not meant to be exhaustive, each of the new claims 36-92 is broader in at least one respect than the claims of the post-disclaimer original patent. See, In re Ruth, supra. Thus claims 36-92 should not be allowed to issue.

IV. THE ISSUANCE OF A PATENT CONTAINING REISSUE CLAIMS 36-92 FROM THE INSTANT UNITED STATES REISSUE APPLICATION IS ESTOPPED UNDER 37 CFR §41.127

37 CFR §41.127 (2004) provides that a judgment in an interference "disposes of all issues that were, or by motion could have properly been, raised and decided." (emphasis added). A losing party who "could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move." Id.¹ 37 CFR §41.121 (2004) and the predecessor rule in effect at the time of the '631 Interference, 37 CFR §1.633(h) (removed 2004), each allow for claims from a reissue application to be added to a pending

¹ At the time of the '631 Interference, interference estoppel was codified in 37 CFR §1.658(c) (removed 2004), which provided that an interference settles "all issues which... could have been properly raised and decided in the interference by a motion under §1.633...(f) through (j)." 37 CFR §1.633(h) (removed 2004) allowed for the addition of an "application for reissue" to an interference. These rules were reorganized into their present form effective Sept. 13, 2004. See, 69 FR 49960.

interference. Accordingly, the issues raised by the '882 Reissue could have been properly raised during the '631 Interference and must be subject to the prior adverse judgment.

See also, In Re Kroekel, 803 F.2d 705, 709 (Fed. Cir. 1986) ("The doctrine of interference estoppel is directed to finality of an interference, at least with respect to all issues which *might have been* presented in the interference."); Woods v. Tsuchiya, 754 F.2d 1571, 1579 (Fed. Cir. 1985) ("*Estoppel for failure to file a motion to amend* would prevent a party who fails to file a timely interlocutory motion to amend from later claiming subject matter which could have been added by such a motion"). See also, MPEP §2308.03.

Even claims which cannot be rejected as unpatentable over the lost counts may still be subject to rejection on grounds of estoppel. See, Ex Parte Kimura, 55 U.S.P.Q.2d 1537, 1547-48 (Bd. Pat. App. & Inter. 2000) (holding that a party who has failed to make a preliminary motion under 1.633(c) or (e) (removed 2004) is estopped from prosecuting claims in a reissue that are patentably distinct from a lost count). Thus NCR is not entitled to any claims directed to (or obvious over) subject matter disclosed in the prevailing Bobba '196 application (now Pat. No. 6,974,084) of the '631 Interference based on NCR's own failure to move to put the subject matter of any such claim in issue in the interference.

There is no question that NCR could have filed a motion to join the '882 Reissue to the '631 Interference - but chose not to - even after PSC raised the issue with its

Proposed Count 3. Accordingly, the statutory estoppel of §41.127 must apply to the present case.

Not only could NCR have added the '882 Reissue to the '631 Interference, they were required to add it. 37 CFR §1.662(b) (removed 2004), which was in effect at the time of the '631 Interference, provided that "[a] patentee who files an application for reissue which includes a claim that corresponds to a count shall, in addition to complying with the provisions of §1.660(b), timely file a preliminary motion under §1.633(h) or show good cause why the motion could not have been timely filed or would not be appropriate."² The '882 Reissue was filed during the '631 Interference. Certain of the '882 Reissue claims, namely claims 36-58, were added by preliminary amendment, which stated that certain claims (at least claim 46 and others) were based upon patent claim 18 which corresponded to Count 1 of the '631 Interference.³ NCR was obligated under §1.662(b) to timely file a motion under §1.633(h) to add the '882 Reissue to the '631 Interference, but failed to do so.

During the '631 Interference on April 11, 2001, PSC filed a preliminary motion to Substitute Proposed Count 3 for Counts 1 and 2. As contemporaneously noted, a purpose of this substitution was to "redefine the count to ensure that the count defines patentable subject matter encompassing the various claims of the parties;" i.e. the "ability to scan a fifth side." Instead of responding to this motion, on May 16, 2001, NCR filed a second disclaimer, disclaiming claims 2-17, 19-21, and 33-35 of the Detwiler '289 Patent. NCR

² 1.662(b) was removed on Sept. 13, 2004. See, 69 FR 49960.

³ See, '882 Reissue prosecution history, 3/23/01 Preliminary Amendment at pg. 14.

then filed a Request For Entry of Adverse Judgment, which was granted on June 7, 2001 resulting in an adverse judgment against the Detwiler '289 Patent, and the dismissal of the '631 Interference.

There was never a ruling upon PSC's Motion to Substitute Proposed Count 3, directed toward the scanning of the fifth side, because NCR took an Adverse Judgment rather than address the issues raised by Proposed Count 3. Significantly, the ability of an "L" shaped scanner to scan the fifth side of an object is now the subject of claims of the '882 Reissue. Consequently, NCR is now attempting to capture, through reissue, claims it could have raised in the earlier interference, and actually prevented from being considered by taking an Adverse Judgment.

NCR cannot show good cause why such a motion would have been untimely or inappropriate. It is evident that NCR had sufficient time, as it had time to file its Request For An Adverse Judgment. Such a motion would have also been appropriate, as it would have allowed for the resolution of issues relating to the '882 Reissue without the need for a second interference -- especially in light of PSC's attempts to raise these very issues with its Motion to Substitute Proposed Count Three. Thus, NCR should be estopped from receiving a patent from the '882 Reissue by NCR's failure to move to join the '882 Reissue to the '631 Interference and NCR's failure to oppose PSC's motion.

NCR's attempts to use the '882 Reissue to bypass the judgment of the '631 Interference forces PSC to provoke a second interference – the very result that the statutory interference estoppel seeks to avoid. See, MPEP §2308.03 ("The time for the

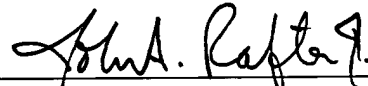
party to make all pertinent arguments is during the interference.") Were this protest denied, a second interference may be required.

Accordingly, because NCR should be estopped from receiving a patent containing claims 36-92, which are subject to the adverse judgment of the '631 Interference, and because the prosecution of the '882 Reissue would result in a second interference, the very thing interference estoppel is intended to avoid, the '882 Reissue of claims 36-92 should not be allowed to issue into a patent.

Respectfully submitted,

Dated: February 10, 2006

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